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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/730,814	12/06/2000	Donald Kyle	332.1114	9564

7590 05/07/2002

Davidson Davidson & Kappel LLC  
485 Seventh Avenue 14th Floor  
New York, NY 10018

EXAMINER

BARTS, SAMUEL A

ART UNIT	PAPER NUMBER
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1621

10

DATE MAILED: 05/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/730,814

Applicant(s)

KYLE ET AL

Examiner

Samuel Barts

Art Unit

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2002.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 8-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 11-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments filed January, 18, 2002 have been fully considered but they are not persuasive. The only remaining issue is the obvious rejection. The argument put forth by applicant is the instant claims are outside the genus of Ajisawa et al and thus not rendered obvious. This is not found convincing because the claimed invention is very close to the genus **and the exemplified species** of Ajisawa et al. In addition, the instant claimed compounds and the prior art compounds have the same utility. Thus, the combination of the close structural similarity with the same utility renders obvious the instant claimed invention.

### *Claim Objections*

2. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 8-19 introduced by the amendment filed January, 18, 2002 have been renumbered 11 to 21. Note claims 8-10 were already present in the case.

3. The indicated allowability of the species 1-[1-benzyl-1-oxo-ethyl)- amino] -2-dibutylamino propyl and 1-[1-benzyl-1-oxo-ethyl)- amino] -2-dibutylamino ethyl is withdrawn upon further consideration. The compounds are structurally similar to the compounds in Ajisawa et al and have the same use. (i.e. both are analgesic). Thus, the

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reference of Ajisawa et al renders the species prima facie obvious. A showing of unexpected results would be strong evidence of patentability.

***Claim Rejections - 35 USC § 103***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 1-7 and 11-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ajisawa et al.

For description of prior art and instant claimed invention see previous office action. For rejection see previous office action. The following points are added to establish a prima facie case over all claims.

The art of Ajisawa et al render more than adjacent homologues obvious. It renders structurally similar compounds obvious. In the instant case, the claimed species differs by one carbon in the variable of  $R_1$  and by one carbon in the variable  $R_2$ . The compound would have been obvious to make, at the time that applicant invention was made, because Ajisawa suggests the compound. The instant claimed compound has the same utility as that taught in Ajisawa et al. A skilled artisan in the pharmaceutical art would have reasonably expected the extension of the carbon chain, of the  $R_1$  and  $R_2$  variable in Ajisawa, to result in another compound that would be useful for the treating of pain. A skilled artisan would have been motivated to make such a change because the extension of carbon chain is well documented as a means to make other compounds with similar pharmaceutical properties but possibly better bioavailability, stability and/or different side effects. Thus skilled artisans in the pharmaceutical art

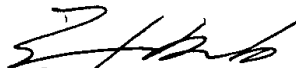
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routinely adjust chain length of compounds to investigate their expected similar pharmaceutical activity. Absent showings of unexpected results the compounds are obvious.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel Barts whose telephone number is 703-308-4630. The examiner can normally be reached on M-F between 6:30am-3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 703-308-1235. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-3081235.

  
Samuel Barts  
Primary Examiner  
Art Unit 1621

s.b.  
May 4, 2002